


PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) 15436.53.1	
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR on _____ Signature _____ Typed or printed name _____	Application Number 10/688,375		Filed October 17, 2003
	First Named Inventor William Freeman		
	Art Unit 2871		Examiner Dung T. Nguyen
Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.  This request is being filed with a notice of appeal.  The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.			
I am the <input type="checkbox"/> applicant/inventor. <input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96) <input checked="" type="checkbox"/> attorney or agent of record. Registration number 45,576 <input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____		 Signature Peter F. Malen Typed or printed name 801-533-9800 Telephone number June 26, 2006 Date	
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.			
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PATENT APPLICATION  
Docket No. 15436.53.1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of		)
	William Freeman et al.	)
Serial No.:	10/688,375	) Art Unit
		) 2871
Filed:	October 17, 2003	)
For:	OPTICAL TRANSCEIVER PACKAGE WITH A LIQUID CRYSTAL VARIABLE OPTICAL ATTENUATOR	)
Confirmation No.:	2218	)
Customer No.:	022913	)
Examiner:	Dung T. Nguyen	)

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop: AF  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

In reply to the Final Office Action mailed January 26, 2006 (the "Final Office Action"), Applicants respectfully request a panel review of the final rejection under 35 U.S.C. § 103(a) discussed in the remarks below. No amendments are being filed with this Request. This Request is being filed concurrently with a Notice of Appeal.

Claims 3, 5, 8, 9, 12, 14 and 16-18 have been withdrawn from consideration, and claims 1, 2, 4, 6, 7, 10, 11, 13, 15, 19 and 20. Claims 1, 2, 4, 6, 7, 10, 11, 13, 15, 19, and 20 have been finally rejected under 35 U.S.C. § 103(a) as purportedly being obvious over US 5,754,571 to Endoh et al. ("*Endoh*") in view of US 5,694,408 to Bott et al ("*Bott*").

### **Legal and Factual Deficiencies**

#### **1. Failure to Address the Arrangement of Components Actually Recited in the Claims**

In the Final Office Action, the Examiner has failed to establish that the cited references, when combined, disclose or suggest the elements arranged as required by each of the rejected claims. For example, in the rejection of claims 1, 2, 4, 6, 7, 10, 11, 13, 15, 19 and 20, the Examiner has asserted that:

“... as stated in the previous office action dated 07/05/2005, Endoh et al. disclose an optical attenuator (figure 6) comprising: a variable liquid crystal rotator having a liquid crystal device (52) a first polarizing element (18) as claimed. Endoh et al., however, do not disclose a faraday rotator and a second polarizing element in the optical attenuator. Bott et al. do disclose adding an isolator such as a faraday rotator element combined with a polarizer (i.e., the second polarizer) as needed (see col. 10, lines 16-17). Therefore, it would have been obvious ... to employ a combination of the ‘Faraday rotator and the polarizer’ in the Endo et al. device as shown by Bott et al. for the benefit of enabling isolator function and preventing backward propagation signals ...”

*Final Office Action, pages 2 and 3. Emphasis added.* It is apparent from this assertion by the Examiner that not only is the Examiner simply repeating a rejection made in a previous action, but also that the Examiner has not asserted, much less established, that the cited references collectively render obvious the specific arrangement of components recited in the rejected claims. Rather than asserting specifically how the purported teachings of *Bott* and *Endoh* should be combined, the Examiner has instead simply made the vague assertion that “... it would have been obvious ... to employ a combination of the ‘Faraday rotator and the polarizer’ in the Endo et al. device as shown by Bott et al.” *Final Office Action* at 3. *Emphasis added.* That is, the Examiner has failed to specifically identify what the Examiner believes to comprise the purportedly obvious combination. Applicant respectfully submits that this vague assertion falls well short of establishing that the references, when combined, teach or suggest the specific arrangement recited in the rejected claims.

In connection with the foregoing, Applicant notes as well that in Applicant’s Paper filed November 7, 2005, Applicant traversed the rejection of the Examiner on the aforementioned basis. See, e.g., *Applicant’s Paper filed November 7, 2005 at pp. 10-11*. In the Final Office Action, however, the Examiner failed to address the arguments set forth by Applicant in Applicant’s Paper filed November 7, 2005, and instead stated:

“Applicants’ only argument is Bott’s teaching are vague since the isolator includes appropriate polarizers in combination with a faraday rotator without disclosing expressly what is considered as an appropriate arrangement of these components while Applicants provide a way of combining a variable optical attenuator with an optical isolator in a compact configuration. The Examiner is not convinced by this argument since the same is true of the combination of the Bott’s Faraday rotator and a polarizer in an optical laser system. In particular, what Bott teaching here is the combination of the Faraday rotator and the polarizer as needed for a particular purpose (i.e., appropriate). In the other words, the modification to the Endoh et al. device to include a faraday rotator and a polarizer and the Applicants’ device would be the same as well.

Accordingly, the limitation of the above claims met.”

*Final Office Action at pp. 3-4.* While Applicant is not clear as to precisely what the Examiner is asserting in the aforementioned statement, inasmuch as the reasoning set forth there appears to be somewhat circular in nature, it nonetheless seems clear that the Examiner has failed to address the substance of the arguments set forth in Applicant’s paper filed on November 7, 2005. In this regard, Applicant notes that “[w]here the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, *take note of the applicant’s argument and answer the substance of it.*” *M.P.E.P. § 707.07(f)* (emphasis added). Inasmuch as the Examiner has failed to answer the substance of Applicant’s arguments, Applicant submits that the rejection of the claims is not well taken and should accordingly be withdrawn.

## **2. Failure to Establish a Suggestion or Motivation to Combine Reference Teachings**

Not only has the Examiner failed to establish that the references, when combined, teach or suggest the specific arrangement recited in the rejected claims, but the Examiner has also failed to establish the existence of a suggestion or motivation to combine the purported teachings of the cited references.

As to the purported motivation to combine *Endoh* and *Bott*, the Examiner has asserted that “... it would have been obvious to one skilled in the art at the time of the invention was made to employ a combination of the “Faraday rotator and the polarizer” in the Endo et al. device as shown by Bott et al. for the benefit of enabling isolator function and preventing backward propagation signals (col. 10, ln. 19).” *Final Office Action at 3. Emphasis added.*

Notwithstanding this assertion, the Examiner has neither asserted, nor established, why “enabling isolator function” in the *Endoh* device would be useful or desirable. Rather, the Examiner simply makes the conclusory statement that “enabling isolator function” in the *Endoh* device would be beneficial. In

this regard, Applicant respectfully submits that the mere fact that a particular functionality can be enabled in a device, and Applicant makes no concession in that regard, is not alone sufficient to establish that there is a suggestion or motivation to do so. See *MPEP* § 2143.01.

As noted above, the Examiner has further asserted that it would have been obvious to modify the *Endoh* device with the purported teachings of *Bott* “for the benefit of ... preventing backward propagation signals.” As in the preceding case however, the Examiner has neither asserted, nor established, why “preventing backward propagation signals” in the *Endoh* device would be beneficial. Again, Applicant notes that the mere fact that a particular functionality can be enabled in a device, and Applicant makes no concession in that regard, is not alone sufficient to establish that there is a suggestion or motivation to do so.

Finally, the Examiner has failed, in any event, to establish that the *Endoh* device suffers from such shortcomings as could, or would, be remedied by application of the purported disclosure of *Bott*. Specifically, the Examiner has not established that the structure and/or operation of the *Endoh* device would give rise to problems such as would, purportedly, be remedied by way of the *Bott* disclosure. In the absence of any proof or evidence that the *Endoh* device experiences backward propagating signals that somehow compromise the performance of that device, and that could be remedied by the *Bott* disclosure, Applicant submits that the Examiner has failed to establish the existence of the requisite motivation to combine the purported teachings of *Endoh* and *Bott*.

### 3. Failure to Establish Likelihood of Success

In connection with the discussion at 1. and 2. above, Applicant notes further that the Examiner has neither explained nor established how the modification of the *Endoh* device with the purported disclosure of *Bott* would enable realization of the benefit asserted by the Examiner to be achieved by way of the purportedly obvious combination – although, as noted above, the Examiner has failed to state specifically what the purportedly obvious combination is. That is, the Examiner has failed to establish that there is any reasonable expectation that the purported disclosure of *Endoh* could be successfully modified with the purported disclosure of *Bott* to provide the asserted benefits. It would thus appear that the assertion of the Examiner as to the achievement of such benefits is, at best, speculative.

### 4. Conclusion

In light of the discussion set forth herein, Applicant respectfully submits that the Examiner has failed to establish a *prima facie* case of obviousness with respect to claims 1, 2, 4, 6, 7, 10, 11, 13, 15, 19, and 20, at least because even if the references are combined as the Examiner has suggested would be obvious to do, the Examiner has failed to establish that the references when combined include all the

limitations of the rejected claims, because the Examiner has not established the existence of a suggestion or motivation to combine the purported disclosure of the cited references, and because the Examiner has not established that there is a reasonable expectation that the purportedly obvious combination, whatever that combination may be, will prove to be successful.

Because the rejections set forth in the Final Office Action include a variety of legal and factual deficiencies, Applicants are entitled to a pre-appeal brief review of the Final Office Action. Moreover, in view of the foregoing remarks, Applicants respectfully request withdrawal of finality of the rejection, reconsideration and reexamination of this application, and the timely allowance of the pending claims.

Dated this 26<sup>th</sup> day of June, 2006.

Respectfully submitted,



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